

Application No. 10/767,472
Attorney Docket No. 1247 P 425
Reply to Office Action Mailed March 3, 2006

Amendments to the Drawings

Please add the attached New Sheet of drawings, containing FIGS. 10-12. These new drawings, along with the amendments to the Specification below, are taken from U.S. Patent No. 6,209,931, which is incorporated by reference into the Application at Page 6, Lines 10-14, and, thus, do not introduce new matter. FIGS. 10-12 illustrate in greater detail the configuration of the lock assembly that contains no adaptor, in which the axis of the actuator is generally in line with the bolt axis.

REMARKS

Claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-35 are pending in the present Application. By this Amendment, claims 11, 26, 28, 29, and 32-35 have been amended, no claims have been cancelled, and new claims 36 and 37 have been added. Accordingly, claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-37 are currently at issue.

I. Examiner Interview

Examiner Schrode and Primary Examiner Barrett conducted a telephonic interview with Applicants' attorney Gregory G. Schlenz on June 1, 2006. Applicants thank Examiners Schrode and Barrett for their time in conducting the interview.

In the interview, pending claims 11, 26, and 35 were discussed, as well as potential and proposed amendments thereto. The Examiner suggested amending claim 26 to recite a first configuration using a first extension bolt and a second configuration using a second extension bolt, and the possibility of claiming the configurations in a method claim was also discussed. U.S. Patent No. 1,094,143 to Hagstrom was also discussed relative to claims 11, 26, and 35. In regard to the Examiner's drawing objection, the Examiner suggested adding more drawing figures and description, and U.S. Patent No. 6,209,931, which is incorporated by reference into the Application, was discussed with relation to the drawing objection.

II. Amendments to the Drawings and Specification

As described above, the amendments to the drawings and the specification are taken from U.S. Patent No. 6,209,931, which is incorporated by reference into the Application at Page 6, Lines 10-14. Thus, these amendments do not introduce new matter.

Additionally, Applicants submit that the new drawing figures and accompanying description addresses the Examiner's objections to the drawings on Page 2 of the Office Action. The new FIGS. 10-12 illustrate in greater detail the configuration of the lock assembly that contains no adaptor, in which the axis of the actuator is in line with the bolt axis.

III. Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 26-33 and 35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,094,143 to Hagstrom ("Hagstrom"). Applicants submit that claims 26-33 and 35, as amended, are patentable over Hagstrom. In the Office action, the Examiner also rejected claims 26 and 34 under 35 U.S.C. § 102(b) as being anticipated by Applicant's prior art. Applicants submit that claims 26 and 34, as amended, are also patentable over Applicant's prior art.

In order for a reference to constitute a §102(b) bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983). It is well-settled law that the burden of establishing a prima facie case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Claim 26, as amended, recites that the lock assembly has a first configuration, "wherein the actuator is connected to a first extension bolt extending along a first bolt axis and the axis of the actuator is in alignment with the first bolt axis," and a second configuration, "wherein the actuator is connected to a second extension bolt extending along a second bolt axis through an adaptor body, the adaptor body spacing the axis of the actuator a distance away from the second bolt axis." Applicants submit that Hagstrom does not disclose, teach, or suggest at least this element of claim 26.

The Examiner has asserted that the locking mechanism of Hagstrom is capable of having two configurations as recited in the previous form of claim 26. Applicants respectfully disagree, as no such capability is disclosed in Hagstrom. However, Applicants have amended claim 26 to positively recite a lock assembly having two different configurations, rather than simply being configured for having two different configurations. Hagstrom does not disclose a lock assembly having two different configurations as recited in claim 26. At most, Hagstrom only discloses a lock assembly having a configuration where the axis of the alleged actuator is spaced a distance away from the axis of the alleged extension bolt. Thus, Hagstrom does not disclose, teach, or suggest this element of claim 26, and does not anticipate claim 26.

Claims 27-33 and 35 depend from claim 26 and contain all the elements of claim 26. Thus, for the reasons set forth above with respect to claim 26, Hagstrom does not anticipate claims 27-33 and 35.

Applicants also submit that Applicants' prior art does not disclose, teach, or suggest at least the above element of claim 26. The Examiner has asserted that the prior art locking mechanism disclosed by Applicants is capable of having two configurations as recited in the previous form of claim 26. Applicants respectfully assert that the prior locking mechanism was not capable of having a second configuration before the time of Applicants' invention, and thus, cannot be used to anticipate claim 26 as previously written. However, Applicants have amended claim 26 to positively recite a lock assembly having two different configurations, rather than simply being configured for having two different configurations. Applicants' prior art does not disclose a lock assembly having two different configurations as recited in claim 26. Applicants' prior art only discloses a lock assembly having a configuration where the axis of the actuator is in alignment with the axis of the extension bolt. Thus, Applicants' prior art also does not disclose, teach, or suggest this element of claim 26, and does not anticipate claim 26.

Claim 34 depends from claim 26 and contains all the elements of claim 26. Thus, for the reasons set forth above with respect to claim 26, Applicants' prior art does not anticipate claim 34.

Applicants note that the "first configuration," having the "first extension bolt" recited in claim 26 is illustrated in greater detail in new FIGS. 10-12, as suggested by the Examiner in the Interview.

IV. Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-3, 5-8, 11-14, 16, 17, and 19-24 under 35 U.S.C. § 103(a) as being unpatentable over Hagstrom. Applicants submit that the Examiner has not established a prima facie case of obviousness with respect to claims 1-3, 5-8, 11-14, 16, 17, and 19-24.

Applicants note that in the Office Action, the Examiner explicitly rejected only claims 1-3, 5-8, 13, 18, 19, 23, and 24 over Hagstrom. However, because the Examiner asserted

arguments for other claims besides those explicitly rejected, Applicants have treated the Office Action as rejecting claims 1-3, 5-8, 11-14, 16, 17, and 19-24 as unpatentable over Hagstrom.

It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *See In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

A. Claims 1-3 and 5-8

Claim 1, as amended, includes, among other elements, “an adaptor having a first end with a projection configured for mating connection to the actuator, and a second end with threading configured for mating securement with the extension bolt.” Applicants submit that Hagstrom does not disclose, teach, or suggest this element of claim 1, and further, there is no motivation to modify Hagstrom to include this element.

The Examiner admits that Hagstrom does not teach that the second end of the alleged adaptor (40, 41, 54, 55, 56, and 53) is threaded for mating with the alleged extension bolt (51, 46, and 45). Additionally, there is no motivation to modify the structures of Hagstrom to include a threaded connection. The Examiner asserts that one of skilled in the art would be motivated to use a threaded connection “for the purpose of preventing the extension bolt from moving side to side and separating from the adaptor.” However, this is purely speculation by the Examiner, as there is no indication that this was a problem in Hagstrom. In fact, Applicants submit that threaded connections existed at the time of Hagstrom’s disclosure, and if it were obvious and beneficial to include a threaded connection rather than the chosen connection, Hagstrom would have done so. Further, Applicants restate that the Examiner’s reliance on Applicants’

specification is improper. First, such reliance on Applicants' specification to render a claim obvious is the very definition of improper hindsight analysis. Second, Applicants have never stated that the threaded end is not critical to the invention. The threaded connection is preferred because it functions better than other types of connections (which is why Applicants have claimed it), even though Applicants recognize that other connections could be used. The Examiner's rationale punishes Applicants for disclosing the invention (and possible variations thereof) more broadly. This is clearly contradictory to the spirit of the patent laws, which favor broad disclosure, and is therefore improper. Accordingly, there is no motivation to modify Hagstrom to include a threaded connection as recited in claim 1, and thus, the Examiner has not established a *prima facie* case of obviousness with respect to claim 1.

Claims 2, 3, and 5-8 depend from claim 1 and contain all the elements of claim 1. Thus, for the reasons set forth above with respect to claim 1, the Examiner has not established a *prima facie* case of obviousness with respect to claims 2, 3, and 5-8.

B. Claims 11-14

Claim 11, as amended, includes, among other elements, "the adaptor connecting the actuator member and extension bolt is positioned more proximate to the central lock assembly than to the distal end of the extension bolt." Applicants submit that Hagstrom does not disclose, teach, or suggest this element of claim 11, and further, there is no motivation to modify Hagstrom to include this element.

The Examiner asserted that the word "proximate" has a broad interpretation and that it would be obvious to one of ordinary skill in the art that Hagstrom's alleged adaptor is positioned proximate to the central lock assembly. Accordingly, Applicants have amended claim 11 to further clarify that the adaptor is positioned more proximate to the central lock assembly than to the distal end of the extension bolt. Hagstrom clearly does not disclose this arrangement. Additionally, there is no motivation to modify Hagstrom to move the alleged adaptor proximate the central lock assembly. Hagstrom teaches that the alleged adaptor (40, 41, 54, 55, 56, and 53) is immediately proximate the alleged extension bolt (51, 46, and 45). (See Hagstrom, FIGS. 1 and 2). Accordingly, modifying the locking mechanism of Hagstrom to move the alleged

adaptor to a position proximate the central lock assembly would be discouraged by the disclosure of Hagstrom. Further, the Examiner has not asserted that such a modification would be obvious. Thus, there is no motivation to modify Hagstrom to reach the invention of claim 11, and the Examiner has not established a *prima facie* case of obviousness with respect to claim 11.

Claims 12-14 depend from claim 11 and contain all the elements of claim 11. Thus, for the reasons set forth above with respect to claim 11, the Examiner has not established a *prima facie* case of obviousness with respect to claims 12-14.

C. Claims 16, 17, and 19-24

Claim 16, as amended, includes, among other elements, “the means for connecting the second end of the adaptor to the elongated extension bolt includes a threaded fastener arrangement between the adaptor and the extension bolt.” Applicants submit that Hagstrom does not disclose, teach, or suggest this element of claim 16, and further, there is no motivation to modify Hagstrom to include this element.

As stated above with respect to claim 1, Hagstrom does not teach that the second end of the alleged adaptor (40, 41, 54, 55, 56, and 53) is threaded for mating with the alleged extension bolt (51, 46, and 45), and there is no motivation to modify the structures of Hagstrom to include such a threaded connection. Thus, for the reasons set forth above with respect to claim 1, the Examiner has not established a *prima facie* case of obviousness with respect to claim 16, or dependent claims 17 and 19-24, which include all the elements of claim 16.

V. New Claims

Claim 36 recites a method of assembling a locking door assembly, including, among other steps, “selecting between installing the lock assembly in a first configuration and installing the lock assembly in a second configuration,” which configurations are similar to those recited in claim 26. Even if the Examiner was correct in the Office Action that Hagstrom and/or Applicants’ prior art were capable of being modified to have two different configurations, the law is clear that while an apparatus claim can be anticipated by a prior device that is similarly

constructed and capable of performing the same function, it is not so with a method claim. *See Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 424 (1902). It is not enough that a prior device could be used to practice the claimed method. *See, e.g., Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303 (Fed. Cir. 2004). Thus, new claim 36 is patentable over the cited prior art.


Claim 37 includes, among other elements, “the first end of the adaptor directly connected to the actuator member, and the second end of the adaptor directly connected to the extension bolt.” None of the cited prior art discloses, teaches, or suggests at least this limitation of new claim 37. For example, in Hagstrom, a long connecting rod (41) separates the alleged actuator from the alleged adaptor, as shown in FIG. 1. There is no direct connection between the adaptor and actuator member as recited in claim 37. Thus, new claim 37 is patentable over the cited prior art.

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CONCLUSION

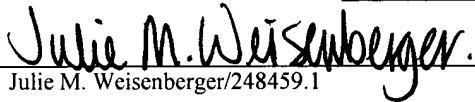
In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of Claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-35 in the present Application. Applicants also respectfully request examination and allowance of new claims 36 and 37. Applicants further request reconsideration and withdrawal of the Examiner's objections to the drawings. Applicants submit that the Application is in condition for allowance and respectfully requests an early notice of the same.

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Respectfully submitted,
By: 
Paul J. Nykaza, Registration No. 38,984
Gregory G. Schlenz, Registration No. 55,597
Wallenstein & Wagner, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312-554-3300

CERTIFICATE UNDER (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop RCE, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 3, 2006.


Julie M. Weisenberger/248459.1